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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,511	12/20/2000	Peter Landrock	105005-0044C1	3110
24267	7590	02/24/2006	EXAMINER	
CESARI AND MCKENNA, LLP			RETTA, YEHDEGA	
88 BLACK FALCON AVENUE			ART UNIT	
BOSTON, MA 02210			PAPER NUMBER	
			3622	

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/747,511

Applicant(s)

LANDROCK, PETER

Examiner

Yehdega Retta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-61 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 25-61 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

This office action is responsive to amendment filed November 30, 2005. Claim 33 has been amended. Claims 25-61 are currently pending.

Requirements for Information

37 CFR 1.105 states: (a) (1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under' 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

- (I) Commercial databases: The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.
- (ii) Search: Whether a search of the prior art was made, and if so, what was searched.
- (iii) Related information: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.
- (iv) Information used to draft application: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.
- (v) Information used in invention process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention

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process, such as by designing around or providing a solution to accomplish an invention result.

- (vi) Improvements: Where the claimed invention is an improvement, identification of what is being improved. (vii) In Use: Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

- (2) Where an assignee has asserted its right to prosecute pursuant to' 3.71 (a) of this chapter, matters such as paragraphs (a)(1)(I), (iii), and (vii) of this section may also be applied to such assignee.

- (3) Any reply that states that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will be accepted as a complete reply.

- (b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

- (c) A reply, or a failure to reply, to a requirement for information under this section will be governed by " 1.135 and 1.136.

The Office is requiring submission of information reasonably necessary to properly examine and treat the claimed subject matter under Rule 105. *Of particular interest is where the claimed invention is an improvement, identification of what is being improved and Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use. And information used in drafting the present operation including information related to the field of endeavor or business practices used by applicant's*

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professional business ventures, to show the information used in the invention process, and identification of any use of the claimed invention known to the inventor at the time the application was filed notwithstanding the date of the use.

Applicant indicated that the security architecture of Bolero project was designed by the applicant. Applicant's specification also mentions the Annexed Tedis II B7 document (page 9 of the specification), which discloses tamper-proof carrier such as chip card and a Trusted Third party. The specification also mentions the so-called "splitting" of a purchased cheque as being the preferred feature for electronic bank cheques. No IDS was submitted regarding such information or regarding prior art on electronic bill of lading, electronic negotiable document or electronic cheques. It appears that it would be appropriate to require the applicants to provide the information mentioned above which is necessary to ensure a quality examination to be performed by the Office.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an

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international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 25-30 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Houser et al. (US 5606609).

Regarding claims 25, 28, 33, Houser teaches creating an electronic document (110) and storing in a tamper resistant document hardware (fig. 1), the hardware containing a unique public-secret key pair (see col. 9 lines 36-40); unique document carrier identifier (see col. 12 lines 55-67, Internet address or system identification); signing the unique identifier, the data and the data identifier (serial number), using the secret key of the public-secret key pair and storing the result in the hardware (see col. 5 lines 3-30, col. 9 lines 36-46, col. 11 lines 57 to col. 13 lines 20, col. 14 lines 36-65,

Regarding claims 26, 27, Houser teaches generating a time stamp representing the time of the issue; calculating a hash value of the data and/or the time stamp value and storing the hash value (see col. 19 lines 38-67).

Regarding claim 29, Houser teaches water mark unique to the issuer (see col. 4 lines 47-60, col. 5 lines 50-65, col. 7 lines 44-59).

Regarding claim 30, Houser teaches encrypting the hash value (see col. 13 lines 4-19, col. 14 lines 11-24).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 60 is rejected under 35 U.S.C. 102(a) as being anticipated by BOLERO (see article I “ELECTRONIC DATA INTERCHANGE” UNITED NATIONS COMMISSION ON INTERNATIONAL TRADE LAW, Working Group on Electronic Data Interchange Thirtieth session, Vienna, 26 February – 8, March 1996 and article II, the “REVIEW OF MARITIME TRANSPORT 1998”, Chapter VI, Trading Transport Efficiency, UNITED NATIONS, New York and Geneva 1998” article.

Regarding claims 60 and 61, BOLERO teaches electronic negotiating an END sold by seller to a buyer in which the END is negotiated with separately with one or more further buyers, subjected to digital signature (see article I page 21-22, article II page 85-88).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31, 32, 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Houser in view of Hartman Jr. (US 5,224,166).

Regarding claims 31, 32, 34 and 35, Houser does not explicitly teach encryption status flag, it taught in Hartman (see col. 6 lines 1-8, col. 7 lines 32-53). Hartman teaches status flag

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indicating whether information is encrypted or not. It would have been obvious to one of ordinary skill in the art at the time of the invention to implement Hartman's status flag for the intended use so that the control means is responsive to the state of the flag in performing its function (see col. 8 lines 37-59).

Claims 36-51 are rejected under 35 U.S.C. 103(a) as being unpatentable Houser and further in view of Hartman Jr. (US 5,224,166).

Regarding claims 36 and 37, 46-49, Houser teaches encrypting document using public or secret key encryption (see col. 13 lines 4-20). Applicant back ground also teaches that it is well known for data from a seller's document carrier to be encrypted using the public key of the buyer document carrier, transmitted to the buyer, and decrypted using the buyer's secret key (see page 3). Houser does not explicitly teach encryption status flag, it taught in Hartman (see col. 6 lines 1-8, col. 7 lines 32-53). Hartman teaches status flag indicating whether information is encrypted or not. It would have been obvious to one of ordinary skill in the art at the time of the invention to implement Hartman's status flag for the intended use so that the control means is responsive to the state of the flag in performing its function (see col. 8 lines 37-59).

Regarding claims 38-45, Houser teaches installing a certificate comprising a digital signature of its unique identifier and of its public key; stored in seller's document carrier; verification of the signature (see col. 7 lines 43-60, col. 13 lines 3-20, col. 14 lines 11-51, col. 15 lines 4-15, col. 14 lines 37-51).

Regarding claims 50 and 51, Houser teaches verifying the data is still valid (see col. 15 lines 54 to col.16 line 23).

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Claims 52-59 are rejected under 35 U.S.C. 103(a) as being unpatentable Houser in view of Hartman and further in official notice.

Regarding claims 52 and 53, Houser does not teach providing the buyer with secret key has been reproduced by issuer or third party. Official notice is taken that is old and well known in the art of crypto to recover a secret key by redistribution. It would have been obvious to one of ordinary skill in art at the time of the invention to reproduce a secret key in order to again provide security.

Regarding claims 54 and 55, Houser does not explicitly teach activating a back-up to recover a lost document. Official Notice is taken that is old and well known in the art at the time of the invention to provide back-up for the intended use of recovering lost document.

Regarding claim 56-59, Houser does not explicitly teach inhibiting the recovery until the expiry of a predetermined period of validity. Official notice is taken that is old and well known in the art of cryptography to check the validity of the encryption key. It would have been obvious to one of ordinary skill in the art at the time of the invention to add such feature for the intended use of insuring that the time interval or period during which the temporary key pair is valid.

Response to Arguments

Applicant's arguments filed November 30, 2005 have been fully considered but they are not persuasive.

Applicant argues that Houser is not concerned with electronic negotiable documents. Examiner is aware that Houser teaches creating an electronic document which covers all kind or electronic document, storing the document in tamper-resistance hardware, etc. Therefore, unless the electronic negotiable document is encrypted or signed differently than the Houser's

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electronic document there is no patentable different between the negotiable document claimed and the electronic document of Houser. Applicant cited section in the background of Houser's disclosure to indicate that Houser teaches away from the claimed invention. The background of Houser teaches what was known before the invention. Houser states in the last paragraph of the background (col. 3 lines 42-45) that there is a need for electronic data security techniques that are user-friendly, that provide a sufficient degree of security that will deter forgery and alterations and that can be used in a wide variety of computer system. Examiner does not believe that Houser teaches away from the claimed invention. Applicant argues that Houser does not teach a tamper-resistance hardware. According to Applicant's disclosure a tamper-resistance hardware is smart cards or a workstations. The specification further discloses that "Tamper-proof or tamper-resistant" means that the functionality of the device cannot be changed, and that any attempt to do so can be readily detected, in many cases, the device could simply be destroyed by tampering. Houser's system requires access password to prevent unauthorized access to the various features of the electronic document security application (see col. 9 lines 20-60), therefore, is a tamper-resistance hardware.

Regarding claim 35, applicant argues that the claim recites "a counter for storing a serial number representative of the number of times the END has been negotiated". Applicant's specification indicates that the END can be negotiated only once, from one document carrier to one other document carrier.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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RETTA YEHDEGA
PRIMARY EXAMINER